

REMARKS

This application has been reviewed in light of the FINAL REJECTION mailed July 18, 2006. Reconsideration of this application in view of the below remarks is respectfully requested. Claims 1 – 30 are pending in the application.

The present Office Action fails to address Applicant's remarks presented in a response dated February 7, 2006, but rather appears to only address arguments presented in a subsequent supplemental response dated April 5, 2006.

Therefore, a telephone interview with the Examiner was initiated on September 15, 2006 to discuss this oversight. As a result of the conversation, the Examiner acknowledges that the present Office Action is deficient for failing to address the remarks presented in Applicant's response of February 7, 2006. In accordance with the Examiner's suggestion, Applicant respectfully requests a withdrawal of the present Office Action and issuance of a new Office Action after full consideration of the Applicant's remarks submitted in the responses dated February 7, 2006 and April 5, 2006.

While the Examiner stated that arguments on the merits of the rejections do not need to be present with respect to the present Office Action, Applicant resubmits the previous remarks from both the original and the supplemental responses in an effort to simplify the Examiner's review of the arguments. Therefore, the following remarks reiterate the remarks submitted in Applicant's responses dated February 7, 2006 and April 5, 2006, responsive to the Office Action dated October 7, 2005. No new arguments are provided below beyond those made in the previous responses.

I. In The Response Dated February 7, 2006

Applicant respectfully submits that the Office Action has not made out a *prima facie* case that the claims are obvious, nor that the references teach or fairly suggest what is attributed to them. For example, the Office Action alleges that Shimizu teaches the features of claim 1, except that the watermark relates to copyright information (p. 3). The Office Action refers to a "Process of Logging On" section that does not appear in either the English language abstract of Shimizu in the IDS submitted 15 November 2004, nor anywhere in the corresponding English language equivalent U.S. Pat. No. 6,971,012. Therefore, there is no evidence of record that Shimizu teaches what is attributed to it in the Office Action.

Moreover, the Office Action improperly removes a key term from the recitation of the claim, namely the "detection result adjustment means for [**adjusting**] a detection [**result**] of said electronic watermark..." (ellipses from Office Action p. 2 replaced). The words excised by the Office Action significantly alter the meaning of the recited claim element. The claim rejected in the Office Action does not even remotely resemble the claim on file. It has been held by the courts that the Office may not properly dissect a claim, excise subject matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. See, *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983) (citing *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1, 9 (1980)). See also, Department of Commerce, Patent and Trademark Office, "Examination Guidelines for Computer-Related Inventions," § II(B), 61 Fed. Reg. 7478, 7480 (Feb. 28, 1996).

Turning now to the additional references of Takashi and Kato, the Office Action's characterizations of these references are also not supported by the text of the English language abstracts, nor any other English language document of record. For example, Takahashi makes no mention of copyright data on the face of its English language abstract. Therefore, the assertions

as to the teachings of these references are insufficient. Assertions not based upon any evidence of record lack substantial evidence support, and should be reversed. See, *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693 (Fed. Cir. 2001), *on remand from Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999).

Moreover, Kato pertains to a digital recording device, which is completely non-analogous to watermark detection apparatus. Therefore, even assuming *arguendo*, that Kato teaches what is attributed to it, one skilled in the art would not look to a digital recording device such as Kato to combine with an electronic image watermark system of Shimizu. “Those of ordinary skill in the art may be presumed to have knowledge of arts “reasonably pertinent to the particular problem with which the inventor was involved.” *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). However, that prior art may not be gathered with the claimed invention in mind. *In re Antle*, 444 F.2d 1168, 1171, 170 USPQ 285, 287 (CCPA 1971).” *Pentec, Inc. v. Graphic Controls Corp.*, 227 USPQ 766, 768-69 (Fed Cir, 1985)

Therefore, because the Office Action does not set forth evidence to support the asserted teachings of the references; because the claims were substantively altered to reach the determination that their features are taught by the references; and because even presuming the references teach what is attributed to them, the rejection proposes a combination of non-analogous art, Applicant respectfully submits that the rejection is poorly taken, and kindly requests favorable reconsideration and withdrawal. Only claims 1-10 are addressed in any depth in the Office Action. Claims 11-20 and 21-30 are rejected as analogous to claims 1-10. Claims 2-10 each depend, either directly or indirectly, from claim 1. These dependent claims are each separately patentable, but are offered as patentable for at least the same reasons as their underlying independent base claim. Claims 12-20 depend from independent claim 11, and claims

22-30 depend from independent claim 21. As the Office Action extends the rejection to these claims by analogy, the insufficiency of the rejection similarly compels that the rejection of all claims be reconsidered and withdrawn.

II. In The Supplemental Response Dated April 5, 2006

Independent claim 1 recites an electronic watermark detection device comprising a detection result adjustment means for adjusting a detection interval of an electronic watermark based on a detection result of an electronic watermark detection means. The Office Action alleged that this feature was taught by Shimizu. Applicant respectfully disagrees.

In contrast to the claimed invention, Shimizu attempts to improve the reliability of watermark extraction, even when the degree of embedding of the watermark is weakened. Specifically, Shimizu prepares the embedded information as a bit string, changes the sign of this bit string, and embeds the bit string, which has the changed sign, into a frame. Thereafter, Shimizu detects embedded information by comparing the accumulated observation result with a variable threshold value. Therefore, Shimizu does not disclose the point of adjusting a detection interval according to the detection result of an electronic watermark, as recited in the independent claim.

Turning then to Kato, the reference discloses a method for shortening the processing time of a CPU, wherein CPU processing is performed only by detecting that control information has changed. In other words, Kato is related to a method of embedding having a high correlation with picture compression processing by DCT. On the other hand, Takahashi discloses a method of embedding information into digital image data. More specifically, Takahashi is related to a method of embedding having improved performance of adaptation processing for minimizing

image quality degradation. Therefore, both secondary references are clearly distinguished from the watermark detection features recited in the claims of the present application.


Again, as the Office Action extends the rejection of claims 1-10 to encompass claim 21-30 by analogy, the patentable distinction of claim 1 and its dependent claims over the prior art similarly compels that the rejection of all claims be reconsidered and withdrawn.

CONCLUSIONS

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 1 – 30 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,



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